

REMARKS

Claims 1-9 and 13-25 were pending. By this Amendment, claims 1, 13, and 19 are amended. No new matter is entered by this Amendment.

Applicants ask that the finality of prior Office Action be withdrawn

Applicants respectfully ask the Examiner to withdraw the finality of the Office Action dated December 17, 2004 because it raised a new issue to which Applicants have not had an opportunity to respond. Specifically, the Examiner rejected claims 1, 2, 9, and 13-16 as being anticipated by U.S. Pat. No. 5,906,644 to Powell ("Powell") on the new ground that those claims did not positively recite the friction-tight press fit (Office Action, December 17, 2005, page 5).

The Examiner did not raise this issue in the non-final Office Action dated May 27, 2004. The Applicants' amendment filed September 27, 2004 did not necessitate this new ground of rejection. For these reasons, Applicants ask that the present amendment be entered.

Claim rejections - 35 U.S.C. § 102

Claims 1, 2, 9, and 13-16 were rejected as reading on subject matter anticipated by U.S. Pat. No. 5,906,644 to Powell ("Powell").

Applicants ask the Examiner to reconsider this rejection. Claim 1, as amended, defines a prosthesis in which a cylindrical portion of a spigot is engaged in a cylindrical portion of a bore by a press fit. This is a cylindrical press fit because the two pieces fitted together have cylindrical cross sections.

Powell does not describe a cylindrical press fit. Instead, it describes a tapered press fit between tapered post 22 and tapered bore 18. The press fit is achieved by advancing a

threaded locking bolt 34 through "tapered bore 18 and post 22" (col. 5, lines 25-26) into a threaded aperture 44 (col. 5, lines 38-48). This arrangement is known as an expanding collet mechanism (col. 5, line 21-22) because the bolt flexes the post so that it presses against the bore.

Powell describes taper fits, not the cylindrical press fit recited in claim 1. For this reason, it does not anticipate the subject matter of claim 1, 2, or 9.

Claim 13 defines a prosthesis in which a locking band of a spigot is to be engaged in a receiving portion of a bore by a press fit. The claim requires that both the locking band and the receiving portion have constant cross-sectional geometries along their lengths.

As stated above, Powell describes only tapered press fits. Powell's tapered bore and post do not meet claim 13 because they do not have constant cross-sectional geometries along their length. By definition, a tapered part has a cross-sectional geometry that changes along its length (e.g., large cross-section at the top, small cross section at the bottom). Powell does not describe a press fit in which the interacting parts have constant cross-sectional geometries. For this reason, Powell does not anticipate the subject matter of claims 13-16.

Accordingly, Applicants request withdrawal of the rejection and allowance of claims 1, 2, 9, and 13-16.

Claim rejections - 35 U.S.C. § 103(a)

Claims 3, 4, 17, and 18 were rejected as reading on subject matter made obvious by Powell in view of U.S. Pat. No. 5,653,764 to Murphy.

Claim 5 was rejected as reading on subject matter made obvious by Powell in view of U.S. Pat. No. 5,002,578 to Luman.

Claim 6 was rejected as reading on subject matter made obvious by Powell in view of U.S. Pat. No. 5,080,674 to Jacobs et al.

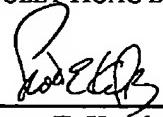
Claims 7, 8, 19, and 20-25 were rejected as reading on subject matter made obvious by Powell in view of U.S. Pat. No. 5,653,765 to McTighe et al.

Applicants ask the Examiner to reconsider each of these rejections. Claims 3-8 and 17-18 depend from claims 1 and 13, respectively, which are allowable for the reasons given above. Claims 19 and 20-25 ultimately depend from allowable claim 1 or claim 13.

Accordingly, Applicants request the withdrawal of the rejections of claims 3-8 and 17-25.

Applicants invite the Examiner to contact their attorney Scott Kamholz to discuss any matter related to this application. Mr. Kamholz can be reached at 617-832-1176 (direct) or at the telephone number listed below.

Respectfully submitted,
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